

Remarks/Arguments

This Amendment is in response to the Office Action mailed January 23, 2007. Claims 1-4, 8-18 and 21-32 are pending in this case. Claims 1-4, 8-18 and 21-32 have been rejected. Claims 1, 8, 12, 15, 18, 26, 29, 30 and 32 have herein been amended. Claim 23 has herein been canceled. New Claim 33 has herein been added. Claims 2-4, 9-11, 13-14, 16-17, 21-22, 24, 27 and 31 remain unchanged.

Claims 1-2, 4, 9-10, 12-14 and 16 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Cordery et al. (US 6,073,125). Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cordery et al. in view of Clark et al. (US 4,829,568). Claims 8, 15, 18, 21-25, 27-28 and 30-31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cordery et al. in view of Simon (US 20030085266). Claims 11, 17, 26, 29 and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cordery et al. in view of Simon and further in view of Pintsov (US 6,009,416). For the following reasons, the Examiner's rejections are respectfully traversed.

It is noted that the above identified rejections are the same as were previously made in the Office Action mailed June 28, 2006. Accordingly, all of Applicants' arguments presented in its prior Amendment dated October 26, 2006 in response thereto are herein incorporated by reference, as though fully stated herein. In summary, Applicants conclusively established that Cordery et al., either alone or in combination with the other cited references, failed to anticipate or make obvious Applicants' claims because Cordery et al.'s encrypted indicia with random digital token K_m does not correspond to a "source" of the mailpieces, such that the mailpieces can be traced back to the "source" by reading the random digital token. Applicants also pointed out that even if a mailpiece's

origin postal code (i.e., zip code) could be determined by Cordery et al., the origin postal code does not correspond to the “source,” but only at most to a general location (e.g., city).

In response to Applicants’ arguments, the Examiner has taken the position that the “source” of a mailpiece “*can be understood as a mail box, a post office, or a city, etc.*” (Final Office Action, p. 12). The Examiner states that this interpretation of the term “source” as being “the original location” (Final Office Action, pp. 8-12) is the “broadest reasonable interpretation.” It is thus clear that the Examiner’s rejections hinge upon this extremely broad interpretation of the term “source.” However, as discussed below, the Examiner’s interpretation of the term “source” is overly broad, and is an unreasonable interpretation given the context of this application.

As stated in MPEP 2111:

During patent examination, the pending claims must be "given their broadest reasonable interpretation *consistent with the specification*." >The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications *not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art."* *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). ...

415 F.3d at 1316, 75 USPQ2d at 1329. See also< *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). (emphasis added) MPEP 2111.

Applicants' respectfully state that the Examiner's interpretation of the term "source" is not consistent with the specification. The term "source" is defined by the Merriam-Webster's Online Dictionary (m-w.com) as:

- 1 a : a generative force : CAUSE b (1) : a point of origin or procurement : BEGINNING (2) : one that initiates : AUTHOR; *also* : PROTOTYPE, MODEL (3) : one that supplies information
- 2 a : the point of origin of a stream of water : FOUNTAINHEAD b *archaic* : SPRING, FOUNT
- 3 : a firsthand document or primary reference work
- 4 : an electrode in a field-effect transistor that supplies the charge carriers for current flow -- compare DRAIN, GATE

Throughout the specification, Applicants consistently and only refer to the "source" of the mailpieces as being the "mailer" or the "mail producer" (See, e.g., specification, p. 5, line 12; p. 6, line 14; page 14, line 6; and Figures 1-2). The entire context of Applicants' specification is that the "source" of the mailpiece refers to the person or entity who produces or creates the mailpieces, i.e., the generative force, the initiator, or the author of the mailpiece. In fact, Applicants specifically state in the specification that the problem with respect to the prior art, which Applicants' method and system solve, is that "[t]ypically, such mail pieces can only be traced back, via a postmark, to the postal facility where it had been processed" (specification, p. 2, lines 26-27). Accordingly, in light of the specification, the Examiner's interpretation of the term "source" is unreasonably broad, and is in fact, not consistent with the specification. As would be understood by one of ordinary skill in the art, in the context of Applicants' specification, the "source" of a mailpiece is the mailer, i.e., the mail producer or creator, and not a location, i.e., mail box, post office or city.

In reiterating the importance of the context of the specification, MPEP 2111.01 cites *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and

limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation.'" 710 F.2d at 802, 218 USPQ at 292 (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original). Thus, it is clear that the Examiner's interpretation of the term "source" is not "reasonable" in the context of Applicants' specification, and is in fact inconsistent therewith.

Even if the term "source" could in general be interpreted as being an "original location," MPEP 2111.01 goes on to point out:

... It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003) (...In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor.)...

If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms. *Brookhill-Wilk I*, 334 F. 3d at 1300, 67 USPQ2d at 1137; see also *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.")... MPEP 2111.01

Clearly, Applicants' specification serves to point away from the improper meaning of the term "source" as being an "original location," and toward the proper meaning of the term "source" as being the mailer or the mail producer or creator. There is no other meaning of the term "source" in the context of Applicant's specification. Accordingly, having clearly established that the broadest reasonable interpretation of the term "source" does not encompass the interpretation made by the

Examiner, Applicants respectfully request that the Examiner reconsider and withdraw the final rejections.

Notwithstanding the same, solely for the purposes of clarification in response to the Examiner's comments in the Final Office Action, and in the interest of passing this application on to immediate allowance, Applicants have herein amended the claims to clarify that the term "source" refers to the mail producer (Claims 1 and 8), the creator of the mail pieces (Claim 12), or the mailer (Claim 30). It is respectfully submitted that these amendments do not raise any new issues which would consider further consideration or search, as these are the very same issues as have been presented and argued at least in the prior Amendment and to which the Examiner specifically responded to in the Final Office Action. It is specifically noted that at least previously presented Claim 32 claimed tracing a code back to the mailer.

With respect to Claim 18, the limitation(s) of canceled Claim 23 has been incorporated therein. Because Claim 18 requires that the mail piece be traced back to an individual, as opposed to a location, it is respectfully submitted that this claim too is allowable over the cited prior art. New Claim 33 has been added and merely reflects a limitation previously presented in Claim 32. Claim 32 has essentially been divided to create new Claim 33, in the interest of clarity. Accordingly, no new matter or issues have been raised by new Claim 33 as well.

It is respectfully submitted that none of the prior art of record, either alone or in combination, fairly teaches, suggests or discloses the novel and unobvious features of Applicants' claims as set forth herein. Accordingly, Applicants respectfully assert that all of the claims as presented herein are now in condition for immediate allowance. An early notice allowance is respectfully requested.


Any arguments of the Examiner not specifically addressed should not be deemed admitted, conceded, waived, or acquiesced by Applicants. Any additional or outstanding matters the Examiner may have are respectfully requested to be disposed of by telephoning the undersigned.

The Commissioner is hereby authorized to charge any fees which may be required to Deposit Account No. 16-0657.

A postcard is enclosed evidencing receipt of the same.

Respectfully submitted,

PATULA & ASSOCIATES, P.C.

A handwritten signature in black ink, appearing to read "C. T. Riggs Jr.", written in a cursive style.

Charles T. Riggs Jr.
Reg. No. 37,430
Attorney for Applicants

PATULA & ASSOCIATES, P.C.
116 S. Michigan Ave., 14th Floor
Chicago, Illinois 60603
(312) 201-8220

27C46